

REMARKS

The issues outstanding in the Office Action mailed March 3, 2008, is solely the rejection under 35 U.S.C. 103 of all pending claims. Reconsideration of this rejection, in view of the following discussion, is respectfully requested.

Claims 1, 4, 7-11 and 13-16 remain rejected under 35 U.S.C. 103 over Findley (CA 2,037,603) taken with Hilder (U.S.P. 6,451,102). Reconsideration of this rejection is respectfully requested.

Findley discloses prior art granules containing pigment, said granules having a size of 10 to 50 microns, and further discloses considerably larger granules in accordance with their invention. The prior art granules are disclosed in Findley as containing carriers which are thermoplastics, see page 1, lines 14-17, while the carriers of the pigments of Findley's invention, on the other hand, all contain stearamide wax, and optionally other ingredients such as EVA copolymers. See page 8, lines 27-30 and examples 2, 3 and 5, for example. The pigments disclosed in Findley are generically said to be "organic" or "inorganic" pigments. See, for example, page 2, lines 24-27 and lines 30-32. As admitted at page 4 of the Office Action, Findley does not disclose flake-form effect pigments, e.g., pearlescent pigments, metal effect pigments, etc. as in independent claims 1 and 9. However, the Office Action argues that it would be obvious to use the high aspect ratio pigments such as pearl luster pigments as disclosed in Hilder, in the compositions of Findley. Applicants respectfully disagree.

At column 1, lines 27 through end of Hilder, difficulties in processing pearlescent pigments are noted. In particular, Hilder teaches that the pigments cause clogging ("hopper bridging") and flow issues because the flake-type pigments tend to compact when processed. Hilder provides a solution to this problem, by coating such pigments with polar waxes or *non-polar* copolymers, such as polyethylene or polypropylene (see column 2, lines 25-27). Without such coating, one of ordinary skill would be dissuaded from using high-aspect pigments in the primary reference process, for fear of clogging. Thus, what is argued to be obvious in the Office Action, is necessarily the use of Hilder's flake-form pigments, coated with polar wax or *non-polar* copolymer, in the process of Findley in which such pigments would be combined with a carrier which is a stearamide wax *and* Findley's optional polar comonomer. The presence of the polar comonomer would be *necessary* in order for the

present claims to read on the combination. Thus, what is not addressed in this rejection, yet which would dissuade one of ordinary skill in the art from making such combination, is the uncertainty of the effect on the necessary polar wax and *non-polar* comonomer coating of the pigments of Hilder in the presence of the polar copolymer of Findley. Would such a copolymer dissolve the coating on the Hilder pigments, resulting in them being unprocessable? One of ordinary skill in the art simply does not have the necessary reasonable expectation of success required to support an obviousness rejection. See, for example, *In re Laskowski*, 10 U.S.P.Q.2d 1397 (Fed. Cir. 1989). For this reason alone, it is submitted that one of ordinary skill in the art would *not* have found it obvious to use the pigments of Hilder in the process of Findley, and it is submitted that the combination of references does not render the present claims obvious.

Moreover, it is noted that the purported combination of references necessarily would employ the stearamide wax of Findley as a carrier, even where the polar copolymer is also present. Thus, this disclosure fails to suggest a claim such as claim 18, in which the carrier “consists of” an at least partially polar copolymer. This provides additional basis for patentability for this claim.

It is respectfully submitted that all claims are in condition for allowance, and passage to issue is respectfully requested. Should the Examiner have any questions or comments, he is cordially invited to telephone the undersigned at the number below.

No fee is believed due with this reply, however, the Commissioner is hereby authorized to charge any additional fees associated with this response or credit any overpayment to Deposit Account No. 13-3402.

Respectfully submitted,

/Harry B. Shubin/
Harry B. Shubin, Reg. No. 32,004
Attorney for Applicant(s)

MILLEN, WHITE, ZELANO
& BRANIGAN, P.C.
Arlington Courthouse Plaza 1, Suite 1400
2200 Clarendon Boulevard
Arlington, Virginia 22201
Telephone: (703) 243-6333
Facsimile: (703) 243-6410
Attorney Docket No.: MERCK-3135
Date: June 2, 2007